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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,278	02/13/2007	Kurt Lappe	6281-000028/US/NP	8252

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
HINZE, LEO T	

ART UNIT	PAPER NUMBER
2854	

MAIL DATE	DELIVERY MODE
12/01/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/579,278	LAPPE, KURT	
	Examiner	Art Unit	
	LEO T. HINZE	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-16 and 18-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-16 and 18-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20090810*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-7, 9-16 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claims 11-16 are objected to as being of improper dependent form. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In this case, claims 11-16 fail the Infringement Test. It is conceivable that the device claim can be infringed without infringing the base method claim, since the device is for performing the method of claim 1, but it is not required to perform the method of claim 1. See MPEP §608.01(n).

3. Claim 18 is objected to because of the following informalities: there are two "d" steps.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-6, 9-13, 16, and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lappe et al., US 5,565,054 A (hereinafter Lappe) in view of Vaughn et al., US 6,983,686 B2 (hereinafter Vaughn).

a. Regarding claim 1:

Lappe teaches a method for the production of print products by combining various immediately successive processing methods, the method comprising the steps of: coating the print products to be produced with a film (10, Fig. 1) at predetermined positions according to a film print processing method in one method step (col. 1, lines 6-13) comprising: partially coating said print products with a thin adhesive layer (col. 2, lines 10-11); providing a transfer film having at least three layers, namely, a carrier foil, a parting layer and a transfer layer (col. 2, lines 12-14); removing said transfer layer from said carrier foil and transferring it at least partially to said print products with a transfer or printing unit, wherein said transfer layer adheres to the print products (col. 2, lines 15-18).

Lappe does not teach providing an embossing and/or a structure according to an embossing and/or a structure processing method in a further method step, wherein the print products to be produced successively undergo the steps of the method without intermediate storage.

Vaughn teaches a method and apparatus of embossing and printing a web (col. 2, lines 1-8).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lappe to provide an embossing to embossing and

printing processing methods in further method steps, either before or after the processes of Lappe, and wherein the print products to be produced successively undergo the steps of the method without intermediate storage as taught by Vaughn, because one having ordinary skill would know that combining these known prior art methods would provide the printed product of Lappe with additional desirability an functionality through the embossed and printed features.

b. Regarding claim 2, the combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above. The combination of Lappe and Vaughn also teaches wherein the print products to be produced are first coated with a film and then provided with a structure (Lappe and Vaughn could be combined in several ways, but the two most likely are adding Vaughn either before or after the process steps of Lappe; adding Vaughn after Lappe results in coating before embossing).

c. Regarding claim 3, the combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above. The combination of Lappe and Vaughn also teaches wherein the print products to be produced are first provided with a structure and are then coated with a film (Lappe and Vaughn could be combined in several ways, but the two most likely are adding Vaughn either before or after the process steps of Lappe; adding Vaughn before Lappe results in coating before embossing).

d. Regarding claim 4, the combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above. The combination of Lappe and

Vaughn also teaches wherein, in another step of the methods the print products to be produced are printed with color in a printing stage (Vaughn: col. 2, lines 4-8).

e. Regarding claim 5, the combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above. The combination of Lappe and Vaughn also teaches wherein the print products to be produced can be color printed before or after being coated with a film or after being stamped (Lappe and Vaughn could be combined in several ways, but the two most likely are adding Vaughn either before or after the process steps of Lappe; adding Vaughn before Lappe results in coating before embossing).

f. Regarding claim 6, the combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above. The combination of Lappe and Vaughn also teaches wherein the print products to be produced are dried in another step of the method, wherein the drying is carried out after the film coating and/or after applying a color printing (it appears that in both Lappe and Vaughn, the print products would dry naturally after each operation is performed).

g. Regarding claim 9, the combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above. The combination of Lappe and Vaughn also teaches wherein the print products to be produced are submitted to a pressing operation in another step of the method after the film coating (Lappe: pressure roller 16 and counter pressure roller 17, Fig. 1).

h. Regarding claim 10, the combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above. The combination of Lappe

and Vaughn also teaches wherein the transfer film can be controlled with respect to the advance thereof with regard to the printing cylinder independently from the rotation thereof (in combining Vaughn with Lappe, one would retain the ability to individually control the different processing stations).

i. Regarding claim 11, the combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above. The combination of Lappe and Vaughn also teaches a device for carrying out the method according to claim 1, comprising at least one stamping calendar (Vaughn, Fig. 1) as well as at least one film transfer device (Lappe, Fig. 1).

j. Regarding claim 12, the combination of Lappe and Vaughn teaches the device of claim 11 as discussed in the rejection of claim 11 above. The combination of Lappe and Vaughn also teaches at least one printing device to apply an ink to said print products to be produced (Vaughn: col. 2, lines 4-8).

k. Regarding claim 13, the combination of Lappe and Vaughn teaches the device of claim 11 as discussed in the rejection of claim 11 above. The combination of Lappe and Vaughn also teaches wherein a drying unit downstream of the printing device (printed product has time to dry after being printed).

l. Regarding claim 16, the combination of Lappe and Vaughn teaches the device of claim 11 as discussed in the rejection of claim 11 above. The combination of Lappe and Vaughn also teaches wherein the film transfer device comprises a calendar (Lappe: 16, Fig. 1).

m. Regarding claim 18:

Lappe teaches a method for producing a print product, said method comprising:

conveying a base layer (2, Fig. 1) successively and continuously through a plurality of processing steps in which: a.) a base layer is coated with an adhesive layer in a first stage (col. 1, lines 10-11); b.) a transfer film is provided having at least a carrier foil layer, a parting layer and said transfer layer, wherein the transfer layer is separated from the film and adhered to said base layer with a transfer or printing unit in a second stage (col. 2, lines 12-14); e.) the base layer is dried in a drying unit in a fifth stage located downstream of the stages performing steps a.) (base layer has time to dry between steps, Fig. 1) ; and wherein the steps are performed successively without intermediate storage (Fig 1 – no storage of 2 between stages).

Lappe does not teach c.) said base layer is stamped and/or embossed in a third stage before or after said step b.); and d.) the base layer is printed in a fourth stage;

Vaughn teaches a method and apparatus of embossing and printing a web (col. 2, lines 1-8).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lappe to provide an embossing to embossing and printing processing methods in further method steps, either before or after the processes of Lappe, and wherein the print products to be produced successively undergo the steps of the method without intermediate storage as taught by Vaughn, because one having ordinary skill would know that combining these known prior art methods would provide the printed product of Lappe with additional desirability an functionality through the embossed and printed features.

n. Regarding claim 19:

Lappe teaches a combined in-line printing apparatus comprising: a gluing unit to selectively apply an adhesive to a base printing material fed through said printing apparatus (col. 2, lines 10-11); a film transfer device to transfer a transfer layer of a transfer film to said base material, said transfer film having at least a carrier foil layer, a parting layer and said transfer layer (col. 2, lines 12-14); and wherein said base layer interacts with said gluing unit, said structure and/or stamping device, and said film transfer device in succession without intermediate storage (no storage between stages, Fig. 1).

Lappe does not teach a structure and/or stamping device to form a pattern in said base material.

Vaughn teaches a method and apparatus of embossing and printing a web (col. 2, lines 1-8).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lappe to provide an embossing to embossing and printing processing methods in further method steps, either before or after the processes of Lappe, and wherein the print products to be produced successively undergo the steps of the method without intermediate storage as taught by Vaughn, because one having ordinary skill would know that combining these known prior art methods would provide the printed product of Lappe with additional desirability an functionality through the embossed and printed features.

o. Regarding claim 20, the combination of Lappe and Vaughn teaches the device of claim 19 as discussed in the rejection of claim 19 above. The combination of Lappe and Vaughn also teaches wherein said base layer interacts with said film transfer device before said stamping device (Lappe and Vaughn could be combined in several ways, but the two most likely are adding Vaughn either before or after the process steps of Lappe; adding Vaughn after Lappe results in coating before embossing).

p. Regarding claim 21, the combination of Lappe and Vaughn teaches the device of claim 19 as discussed in the rejection of claim 19 above. The combination of Lappe and Vaughn also teaches at least one of a printing device to print a material on said base material (Vaughn: col. 2, lines 1-8), a drying unit to dry said adhesive (Lappe: adhesive dries after being applied, Fig. 1), and a pressing unit having a plurality of calenders to compress said base layer and said transfer layer (Lappe: 16, 17, Fig. 1).

q. Regarding claim 22, the combination of Lappe and Vaughn teaches the device of claim 21 as discussed in the rejection of claim 21 above. The combination of Lappe and Vaughn also teaches wherein said drying unit is downstream of said gluing unit (Lappe: glue begins to dry after application, Fig. 1).

6. Claims 7, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lappe in view of Vaughn as applied to claims 1 and 11 above, and further in view of Miyamoto et al., US 6,033,509 A (hereinafter Miyamoto).

a. Regarding claims 7 and 14:

The combination of Lappe and Vaughn teaches the method of claim 1 as discussed in the rejection of claim 1 above.

The combination of Lappe and Vaughn does not teach wherein a transfer film that has been supplied for the film printing method is stretched in the direction of width.

Miyamoto teaches stretching of a transfer film prior to application to reduce wrinkles in the transfer film (col. 6, lines 28-29)

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Lappe wherein a transfer film that has been supplied for the film printing method is stretched in the direction of width as taught by Miyamoto, because this helps reduce wrinkles in the transfer film.

b. Regarding claim 15, the combination of Lappe, Vaughn, and Miyamoto teaches the device of claim 14 as discussed in the rejection of claim 14 above. The combination of Lappe, Vaughn, and Miyamoto also teaches wherein the expander roller is shorter than the width of the film transfer device (Miyamoto is silent as to width of expander roll 11 and transfer film 2; therefore one having ordinary skill in the art could make roller either only wider or narrower than the film. This decision could easily be made through routine experimentation to arrive at a roller that is narrower than the film).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo T. Hinze whose telephone number is 571.272.2864. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571.272.2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leo T. Hinze
Patent Examiner
AU 2854
18 November 2009

/Judy Nguyen/
Supervisory Patent Examiner, Art Unit 2854